

Remarks

This paper is responsive to the Office Action mailed September 11, 2009. This paper is filed with a request for a 3-month extension of time.

Claims 1-23 are pending in the instant application. In the Action, the Office rejected claims 1-23. Applicant hereby amends claims 1-3, 6-11, 13, 16, and 22, and adds new claims 24-27 which are fully supported by the application as filed.

Rejection – 35 U.S.C. § 112, second paragraph

The Office has rejected claims 1-23 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Without addressing the merits of the rejection and in an effort to advance prosecution, Applicant has removed reference to “precursors” and “analogues.” Applicant respectfully submits that the claims as amended are allowable.

Rejection – 35 U.S.C. § 103(a)

The Office has rejected claims 1-9, 15, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Khanbabaee *et al.* Tetrahedron (1997), Vol. 53, pages 10725-10732. The Office states that Khanbabaee differs from the instantly claimed invention in that Khanbabaee reaches refluxing the reaction mixture in DCM versus conducting the reaction at room temperature, and that generally differences in temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such temperature is critical.

Applicant has amended independent claim 1 to now recite that the method consists essentially of steps a-c. As the Office states on page 3 of the Office Action, Khanbabaee requires separation of the α and β anomers by column chromatography on silica gel. Applicant respectfully asserts that claim 1 as amended to recite that the method consists essentially of steps a-c, none of which are separation of the anomers, is not obvious in light of Khanbabaee. The transitional phrase “consisting essentially of” limits the scope of a claim to the specified steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed

invention. MPEP § 2111.03 and *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). Applicant respectfully submits that the claims as amended are not obvious in view of Khanbabaee and are allowable.

In the event the Commissioner should decide that any additional fee or fee deficiency is due, the Commissioner is hereby authorized to charge any and all fees incurred as a result of entering or considering this document to deposit account number 03-0172.

Respectfully submitted,

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